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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,374	12/15/2000	Masatoshi Arai	1359.1031	7612
21171	7590	07/21/2008		
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			EXAMINER CAMPEN, KELLY SCAGGS	
			ART UNIT 3691	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/736,374

Applicant(s)

ARAI ET AL.

Examiner

Kelly Campen

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

Newly submitted claims 16-17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process as claimed can be practiced by another and materially different apparatus and by hand.

Restriction for examination purposes as indicated is proper because the newly submitted claims are independent or distinct and there would be a serious search and examination burden if restriction were not required because one or more of the following reasons apply:

- (a) the inventions have acquired a separate status in the art in view of their different classification;
- (b) the inventions have acquired a separate status in the art due to their recognized divergent subject matter;
- (c) the inventions require a different field of search (for example, searching different classes/subclasses or electronic resources, or employing different search queries);
- (d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16-17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Drawings***

The drawings were received on 4/24/2008. These drawings are not acceptable because a marked up copy was not included with the submission.

In addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

Figure 10 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The

replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Figure 11 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim is confusing as to what is being claimed. Specifically, the language "wherein the computer processor operations further comprise auctioning again the advertisement tenant of the digital displayable contents, if the digital displayable contents are redistributed. It

appears nothing is being claimed. It is assumed this is a typographical error and the claim should read similar to claim 14. Applicant should correct.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 1-15 are rejected under 35 U.S.C. 102(a) as being anticipated by Miyashita (US 2001/014876).

Specifically as to claim 1, Miyashita discloses a digital contents advertisement display computer system using an auction, comprising: a contents distribution unit; a computer processor; and a computer readable medium storing at least one computer program controlling the computer processor to perform operations comprising: disclosing an outline of digital displayable contents to be distributed through a digital medium to audiences; allowing the audiences, as sponsors, to bid for becoming an advertisement tenant to be displayed in the disclosed digital displayable contents when displaying the digital displayable contents; determining a winning sponsor for the advertisement tenant 'from among the bidding sponsors, according to a highest price bid by a sponsor; and updating the digital displayable contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital displayable contents and distributing the completed digital displayable contents via the contents distribution unit (see pages 4-7, paragraphs 0016, 0026).

Specifically as to claim 2, wherein the computer processor operations further comprise receiving an input from an audience and allowing the audience to influence a scenario process of the displayable contents (see paragraphs 0016, 0026 and pages 4-5).

Specifically as to claims 3 and 4, wherein, in a case where an advertisement tenant is not determined in the determining of the winning sponsor the digital displayable contents is distributed using a default advertisement tenant in the digital displayable contents (see paragraph [0026]. Specifically as to claims 5-6, 11-12, wherein the computer processor operations further comprise controlling behavior of a character displayed on a screen in accordance with a bidding price by a sponsor, wherein the character behaves so that the audience pays more attention to the advertisement tenant for which the bidding price is higher (see paragraph 0016 as it is within the scope and capable of performing the function by negotiating other conditions for attaching).

Specifically as to claims 7 and 8, wherein the computer processor operations further comprise recording an access log with respect to the character, and calculating a degree of attention to the advertisement tenant based on the access log recording, wherein advertising effects can be measured based on the calculated degree of attention to the advertisement tenant (see paragraph 0016 as it is within the scope and capable of performing the function by negotiating other conditions for attaching).

Specifically as to claims 9 and 10, wherein the computer processor operations further comprise changing a display of the advertisement tenant so that a degree of attention to the advertisement tenant in the contents is changed in accordance with a bidding price (see paragraph 0016 as it is within the scope and capable of performing the function by negotiating other conditions for attaching).

Specifically as to claims 13 and 14, wherein if the digital displayable contents are redistributed, the advertisement tenant is auctioned again to the advertisement sponsors (inherent in advertising auctions, see in addition, paragraphs 0010-0026).

Specifically as to claim 15, Miyashita discloses a computer-readable recording medium storing a program to be executed by a computer, for realizing a digital contents advertisement display system using an auction, the program controlling the computer to perform operations comprising: disclosing an outline of digital displayable contents to be distributed through a digital medium to audiences; allowing the audiences, as sponsors, to bid for becoming an advertisement tenant to be displayed in the disclosed digital displayable contents when displaying the digital displayable contents; determining a winning sponsor for the advertisement tenant from among bidding sponsors, according to a highest bid price by a sponsor; updating the digital displayable contents to contain the advertisement tenant, according to requests from the winning sponsor, to complete the digital displayable contents; and distributing the completed digital displayable contents (see above rejections for claims 1-14, in addition, see paragraphs 0011-0029 and pages 5-7).

### ***Response to Arguments***

Applicant's amendments to the Abstract have overcome the objection to the abstract.

Based on the remarks filed 4/24/2008, and the amendments filed 4/24/2008, the rejections under 35 USC 112 have been overcome. While the term "advertising tenant" is not a term used



in advertising, applicants remarks sufficiently defined the term in the specification as emphasized in the remarks filed 4/24/2008.

Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments, see pages 13-14, filed 4/24/2008, with respect to the rejection(s) of claim(s) 1-15 under 35 USC 102 (b) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of the newly applied prior art as a 35 USC 102 (a) rejection.

#### ***Examiner's Note***

Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Giacalone, JR. discloses a system for electronically distributing advertisements.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kelly Campen whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/  
Examiner, Art Unit 3691